

Response Under 37 C.F.R. §1.116 - Expedited Examining Procedure

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Serial No.: 10/000,057

Confirmation No.: 9505

Filed: November 1, 2001

For: ABRASION RESISTANT COATING FOR STACKS OF FIBER CEMENT SIDING

Remarks

The Office Action mailed February 7, 2005 has been received and reviewed. No claims having been amended, the pending claims are claims 17-19, 21, and 31-52.

Reconsideration and withdrawal of the rejections are respectfully requested.

The Final Rejection

"A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." M.P.E.P. §706.07(a).

Applicants respectfully submit that the Final Office Action mailed 7 February 2005 was improper because the Examiner made a rejection final, on prior art not of record, of amended claim 17, which was amended to include limitations which should reasonably have been expected to be claimed. Applicants respectfully request reconsideration and withdrawal of the final rejection.

The 35 U.S.C. §103(a) Rejection

The Examiner rejected claims 17-18, 31-32, and 42-50 under 35 U.S.C. §103(a) as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902). Applicants respectfully traverse this rejection.

"To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings" M.P.E.P. §2143.

Applicants respectfully submit that there is no suggestion or motivation, either in the documents or in the knowledge generally available to one of ordinary skill in the art, to modify the documents. For example, Blum discloses "an aqueous binder composition . . . a

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process for the production of a coating or sealing composition containing this aqueous binder" (e.g., abstract). These compositions can be used for "the painting and sealing of wood and wood materials, such as chipboard, fiber board" (e.g., column 7, lines 8-10) and provide good solvent resistance (e.g., column 8, lines 25, and 40-42). However, Blum does not disclose a coating that is "mar and abrasion resistant" (e.g., present claim 19).

The Examiner asserted that "the reference [Blum] does not exemplify a method of providing a fiberboard cement substrate, coating the substrate with a sealer, coating the sealer with a primer, coating the primer with a decorative coating, coating the decorative coating with a top coating, and curing the top coating" and that "Dai Nippon demonstrates that such a process is conventional in the cement board art" (e.g., page 2 of the Final Office Action mailed 7 February 2005). Applicants earnestly disagree that Dai Nippon demonstrates "such a process."

Dai Nippon discloses an "Inorganic Decorative Board Having Excellent Anti-fouling Property and Production Method Thereof" (e.g., title). Dai Nippon discloses a material that suppresses "the generation of peel-off when being applied in the kitchen . . . and [to] improve the flame-preventing property by successively *laminating* a base coat layer, a picture printing layer, and a top coat layer . . . on the surface of an inorganic substrate 2" (e.g., abstract, emphasis added). Applicants respectfully submit that Dai Nippon's lamination process does not exemplify the methods provided by the present invention (e.g., present claim 19).

Furthermore, although Dai Nippon desires to "form the coat excellent in surface physical properties such as resistance to contamination, abrasion-proof nature, and solvent resistance" (e.g., paragraph [0014]), Dai Nippon does not teach that there is a problem with abrasion nor discloses that topcoat 5 is "mar and abrasion resistant" (e.g., present claim 19). As a result, there is no reason nor suggestion to substitute a top coat of Blum for that of Dai Nippon.

Applicants respectfully submit that the combination of Blum with Dai Nippon in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. In order to establish a *prima facie* case of obviousness, the references must teach or suggest all the claim limitations. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q.

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81 at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, . . . was a legally improper way to simplify the difficult determination of obviousness."). One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Further, the suggestion for combining the teachings of the prior art to make the invention must be founded in the prior art and not in the teachings of Applicants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art does not suggest that the combination of its teachings would result in the present invention.

Applicants respectfully submit that neither Blum nor Dai Nippon address the problem of providing a coating that is "mar and abrasion resistant" (e.g., present claim 19). Therefore, there cannot be motivation to combine the documents to provide a method that results in such a product.

As such, Applicants respectfully submit that claims 17-18, 31-32, and 42-50 are not obvious over the combination of Blum and Dai Nippon. Applicants respectfully request reconsideration and withdrawal of the rejection.

The Examiner rejected claims 51-52 under 35 U.S.C. §103(a) as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902), as applied to claims 17-18, 31-32, and 42-50 above, and further in view of the Applicants' admitted prior art. Applicants respectfully traverse this rejection.

The Examiner asserted that "[t]he applicants admit that traditional practices using fiber cement board materials include a stacking operation for ease of shipping" (e.g., page 4, Final Office Action mailed 7 February 2005). As noted herein above, Applicants submit that there is no motivation for a person of ordinary skill in the art to combine the teachings of Blum and Dai Nippon. Nothing is identified within the Applicants' prior art disclosure that remedies this deficiency.

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As such, Applicants respectfully submit that claims 51-52 are not obvious over the combination of Blum and Dai Nippon, and further in view of the Applicants' admitted prior art. Applicants respectfully request reconsideration and withdrawal of the rejection.

The Examiner rejected claims 33-41 under 35 U.S.C. §103(a) as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902), as applied to claims 17-18, 31-32, and 42-50 above, and further in view of Takahashi (U.S. Patent No. 6,103,352). Applicants respectfully traverse this rejection.

Takahashi discloses a decorative sheet that comprises "a substrate sheet 1; a contiguous layer 4 provided on the substrate sheet 1; and a surface protective layer 5 provided on the contiguous layer 4 containing a compound having active hydrogen, the surface protective layer 5 comprising an ionizing radiation-curing resin and an isocyanate compound, the contiguous layer 4 and the surface protective layer 5 being in a cured state" (e.g., abstract). Further, Takahashi's decorative sheet possesses "high adhesive strength between the surface protective layer and each layer laminated onto the surface protective layer and, in addition, excellent scratch resistance" (e.g., column 1, line 31-34). However, Takahashi does not teach nor suggest a method of "wherein the curing step comprises a *thermal curing* process that does not expose the siding to a board surface temperature in excess of 100°C" (e.g., present claim 17, emphasis added).

As noted herein above, Applicants submit that there is no motivation for a person of ordinary skill in the art to combine the teachings of Blum and Dai Nippon. Nothing is identified within Takahashi that remedies this deficiency.

As such, Applicants respectfully submit that claims 33-41 are not obvious over the combination of Blum and Dai Nippon, as applied to claims 17-18, 31-32, and 42-50 above, and further in view of Takahashi. Applicants respectfully request reconsideration and withdrawal of the rejection.

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The Examiner rejected claims 19 and 21 under 35 U.S.C. §103(a) as being unpatentable over Blum (U.S. Patent No. 5,344,873) in view of Dai Nippon (JP 10-128902), and Takahashi (U.S. Patent No. 6,103,352) as applied to claims 33-41 above, and further in view of Harper et al. (U.S. Patent No. 4,637,860). Applicants respectfully traverse this rejection.

Harper et al. disclose "a process for the manufacture of a non-asbestos corrugated sheet" (e.g. abstract). As noted herein above, Applicants submit that there is no motivation for a person of ordinary skill in the art to combine the teachings of Blum, Dai Nippon and Takahashi. Nothing is identified within Harper et al. that remedies this deficiency.

As such, Applicants respectfully submit that claims 19 and 21 are not obvious over the combination of Blum in view of Dai Nippon, and Takahashi as applied to claims 33-41 above, and further in view of Harper et al. Applicants respectfully request reconsideration and withdrawal of the rejection.

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Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
DARGONTINA et al.

By

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April 21, 2005
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21st day of April, 2005, at 2:07pm (Central Time).

By: Sara E. Olson
Name: Sara E. OLSON